UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,651	11/26/2003	Mansoor Ali Khan Alicherry	6-3	7650

7590 10/06/2008

Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560

EXAMINER	
SILVER, DAVID	
ART UNIT	PAPER NUMBER
2128	

MAIL DATE	DELIVERY MODE
10/06/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ontinuation of item 13: Applicants' remarks regarding dependent claims 12 and 13 have been considered but are unpersuasive as they require further consideration and possible search. Consideration is required fro 35 U.S.C. § 112 compliance. Possible new search is required based on MPEP 608.01(n).III, which recites: "The fact that a dependent claim which is otherwise proper might relate to a separate invention which would require a separate search or be separately classified from the claim on which it depends would not render it an improper dependent claim, although it might result in a requirement for restriction." Meaning, a dependent claim can be drawn to a separate invention. Thus, the currently amended claim requires consideration whether that is the case and whether it requires further consideration.

Regarding the arguments of claims 26 / 27, claim 26 (and its dependent claim 27) depends from claim 24, not claim 25 as stated by Applicants. Accordingly, the remarks are moot.

With respect to the 35 U.S.C. § 101 rejection, Applicants are correct that "one having skill in the art would clearly understand that a processor performs operations by executing stored instructions". However, the arguments are invalid to conclude that due to this, it is inherent that "configured to" means execution of stored instructions. The arguments are incongruent. Specifically, whether one understands that a processor performs operations by executing instructions does not add merit that the language of "configured to" means an active step of performing instruction execution.

Applicants' remarks on page 10 paragraph 2 have been considered but are unpersuasive. Attention is respectfully drawn to, for example, MPEP 2106.01, which recites, in part: "Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See >Diamond v.< Diehr, 450 U.S. *>175,< 185-86, 209 USPQ *>1,< 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the

programming of a general purpose computer.")." Because Applicants' claimed invention is drawn to solely a mathematical algorithm being performed, it is drawn to non-statutory subject matter.

Regarding the arguments on page 10 with respect to the final result, the step of "specifying a line system design" does not bring the claim into the statutory realm because it contains the same deficiency as the step of "representing". Specifically, it is unclear what the term where the specifying takes place, or if it produces a result or merely an internal specifying which si just an abstract mathematical formula.

Applicants' arguments regarding the statutory class (Remarks: page 11 first full paragraph) of the claimed invention have been fully considered and are persuasive.

Applicants' arguments on page 11 lines 4 from bottom to page 12 line 6 have been fully considered and are persuasive.

Applicants' arguments on page 12 second fully paragraph to end of page 12 have been fully considered but are unpersuasive. Specifically, the claim limitations remain drawn to merely intended use, as indicated by the claim language "for use in...". Accordingly, the interpretation is maintained.

The claim language of "so as to achieve a minimum total design cost" is drawn to subject matter that was not given patentable weight as being drawn to intended use. Accordingly, Applicants' arguments on page 13 regarding the prior-art have been fully considered, but are unpersuasive.

The Instant Application, as claimed, is not in condition for allowance.